

REMARKS

Claims 1 – 30 are pending in the application. Claims 1, 9, 10, 14, 15, 19, 21, 26, 29 and 30 have been amended. Claims 1 – 30 remain in the application and are presented for reconsideration.

The Examiner rejected claims 1, 10, 15 and 21 under 35 USC § 112, second paragraph as being indefinite because the claims do not identify the entity that is not “first making any payment.” These claims have been amended to indicate that it is the user that is not first making any payment to play the game.

The Examiner rejected claims 1, 2, 7 – 10, 12 – 15, 17 – 25 and 27 under 35 USC § 102(e) as being anticipated by *Walker, et al.* (U.S. 2003/0054888) in view of *Ghouri, et al.* (U.S. 2002/0082978). This rejection is respectfully traversed. Since a claim cannot be anticipated by a combination of references, this response is treating the rejection as a rejection under 35 USC § 103, with the *Walker, et al.* and *Ghouri, et al.* references being applied as 35 USC § 102(e) references. The Examiner is using both *Walker, et al.* and *Ghouri, et al.* as references because each claims priority to a provisional application filed before the filing date of Applicant's invention on January 12, 2001. In order to use either of these references as prior art based on earlier filed provisional applications, the provisional applications themselves must teach that which the Examiner relies upon for showing aspects of the Applicant's invention in the published applications of *Walker, et al.* and *Ghouri, et al.*

The Examiner rejected the independent claims 1, 10, 15, 21 and 22 applying the same arguments to each claim and specifically applying the *Walker, et al.* and *Ghouri, et al.* references to

the limitations of claim 10. Claims 1, 10, 15, 21, and 22 have been amended to clarify that the user is automatically provided with an option to play a game to win a selected product or service without requesting the option. Support for the amendment is found in the dynamically generated display of Fig. 4 and the accompanying description found at page 9, line 15 to page 10, line 11. Fig. 4 depicts the results of the search query in tabular format along with dynamically displayed options to buy an item or play to win the item. The user is presented with these options automatically without having to request either one. With respect to claim 10, the Examiner stated that *Walker, et al.* teaches transmitting electronic signals representing at least a first option for the user to play a game to win a product without first making any payment (citing paragraph 130) and a second option to purchase the product (citing paragraph 149). In provisional patent application 60/204,763, *Walker, et al.* states that the customer may be able to play for free for a limited number of plays (page 6 of 8) without any teaching of how this can be done. In paragraph 130 of the published application, *Walker, et al.* teaches that no consideration may be required of the customer to play the game in some embodiments. However, *Walker, et al.* further teaches that the customer may provide an alternate form of entry into the game by filling out an entry form and submitting it to an employee of the retailer, such as a cashier. Further, *Walker, et al.* teaches that the customer may also mail in an alternate form of entry by sending a postcard to an address of the retailer indicating a desire to play a game to win a product. In addition, *Walker, et al.* teaches that an alternate form of entry may comprise signing one's name, providing a fingerprint, or simply asking to play the game for free. Taken together, these teachings fail to teach automatically transmitting electronic signals

representing at least a first option for the user to play a game to win a product without the user first making any payment. Furthermore, the teaching of alternate forms of entry into the game of chance for the customer is not disclosed in the provisional application. Therefore, it is not appropriate to apply paragraph 130 of the *Walker, et al.* published application for a teaching of this step of the claim.

At paragraph 149, *Walker, et al.* does not teach purchasing of a product as an option to playing a game to win the prize. In the paragraph cited by the Examiner, *Walker, et al.* teaches that in one embodiment, the customer pays for a product before playing a game to win the product. In other words, the customer buys the product and then subsequently plays the game to try to win the product that he has just bought. In Applicants' invention, the user receives product information (as referred to in Fig. 4) and then has automatically transmitted selectable options either to win the product or to buy it.

The Examiner stated that *Walker, et al.* teaches, at paragraphs 149 – 151, the step of directing the user to a website which sells the product if the user chooses to purchase the product instead of playing the game. Paragraphs 149 – 151 and Fig. 10 of *Walker, et al.* describe a process in which a customer selects a product, payment is then received for the product, and the customer then requests to play a game for the product. In Paragraph 150 in particular, *Walker, et al.* teaches that selection of the product is received by a POS terminal in response to a bar code scanner scanning a bar code corresponding to the product. Paragraph 151 teaches that payment for the product is received using a payment identifier associated with a customer identifier received by the

customer input/output device or through manual input by the customer using the customer input/output device. As further shown in Fig. 10 of *Walker, et al.*, after the customer selects a product and pays for the product, he then requests to play a game to either win the product or to have a portion of the fee for playing the game credited to the customer for playing the game. There is no teaching in *Walker, et al.* of directing the user to a website which sells the product if the user chooses to purchase a product instead of playing the game when presented with the alternative options. In the present invention, the user has the selectable options to win the product or to buy the product. If the user decides to buy the product, a hyperlink takes the user to the product provider's website in order to purchase the product. The examiner rejected claims 1, 15, 21 and 22 for the same reasons that he rejected claim 10. Applicants' remarks regarding claim 10 are equally applicable to claims 1, 15, 21 and 22.

In view of the preceding arguments, claims 1, 10, 15, 21 and 22 are allowable over the combination of *Walker, et al.* and *Ghourri, et al.* even if they could both be applied as prior art. Furthermore, as noted above, certain teachings of *Walker, et al.* relied upon by the Examiner are not found in the provisional application and therefore, cannot be applied to support the Examiner's position. Claims 2-9, 11-14, 16-20 and 23-30 depend from claims 1, 10, 15 and 22, respectively. Each claim is allowable for at least the same reasons that its corresponding base claim is allowable.

Regarding the Examiner's rejection of claim 9, 14 and 19, Applicants have clarified the definition of user behavior by limiting this factor to user behavior occurring during a user session. *Walker, et al.* teaches (paragraphs 88-89) that a customer rating can be used to determine a

probability that a game will result in a winning outcome. A customer rating is associated with a customer's purchasing history. In contrast, in Applicants' invention, user behavior is defined within the limits of a user session. Such behavior can include the user participating in a consumer survey or visiting an advertiser's website during the session at random intervals (see page 19, lines 6-21). This represents a dynamic change in this probability factor during a user session. *Walker, et al.* teaches application of a fixed consumer rating based on past behavior. Therefore, claims 9, 14 and 19 are allowable over the combination of *Walker, et al.* and *Ghoury, et al.* for this additional reason.

With respect to claim 20, the Examiner relies on Fig. 20 of *Ghoury, et al.* for a teaching that electronic signals representing the associated process charged by each of different dealers represents the prices charged on each dealer's own web site. *Ghoury, et al.* teaches, at paragraph 72, that Fig. 20 represents a sample bid results page in a process for reverse auction of customizable products, such as cars. It is very unlikely that dealer bids in the system taught by *Ghoury, et al.* would represent the same price offered on the dealer's web site. In the corresponding provisional patent application 60/236,995, *Ghoury, et al.* teaches (page 6) that the user logs onto a web site after close of bidding to view bids that dealers have made on a previously configured car. The user is not directed to a web site of any dealer. The dealer is not identified until the user accepts a bid on the bid results page. In addition, the 12 sample web pages that are part of provisional patent application 60/236,995 were not provided with the 7 page specification and the examiner is kindly requested to provide those sample web pages in any subsequent office action. In view of the preceding remarks,

the combination of *Walker, et al.* and *Ghour, et al.* fails to teach the limitation of claim 20 which is allowable over this combination of references for this additional reason.

With respect to claims 2, 24 and 27, the Examiner cites *Walker, et al.*, at paragraphs 28 and 89, for a teaching that the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system. These paragraphs in *Walker, et al.* teach that a frequent shopper may have a higher probability of winning a game because of past buying behavior. For a particular user, this probability does not vary during successive plays. This is not relevant to the user's increased chances of winning on successive plays in the present invention which can be the result of viewing an advertisement, taking a survey or locking in a digit in an outcome number to match the user's selected PIN. Therefore, claims 2, 24 and 27 are allowable over the combination of *Walker, et al.* and *Ghour, et al.* for this additional reason.

The Examiner rejected claims 3-5 and 29 under 35 USC § 103(a) as being unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghour, et al.* (U.S. 2002/0082978), and further in view of *Yoseloff* (U.S. 6,331,143). This rejection is traversed.

Claim 3 recites the limitation of displaying a user-chosen number and a comparison number that reflects the outcome of the game play. The probability of winning is independent of the outcome number and PIN (page 18, line 22 – page 19, line 5). In other words, the number selected by the user is not compared to the outcome of the game trial which has its own pseudo-random probability of resulting in a winning outcome. The comparison number displayed is not the actual pseudo-random output of the game trial as it is in *Yoseloff*. If the result is a loss, then the

comparison number generated after the game trial can be generated by a separate pseudo-random number generator. Therefore, claim 3 is not obvious over the combination of references applied by the Examiner.

Claim 4 recites the limitation that the comparison number can be displayed that matches a digit of the user's chosen number. The outcome number taught by *Yoseloff* is always the pseudo-random result of the game trial. There is no "locking in" of a digit as in the present invention. The game outcome is determined based on a probability of winning that can increase with user behavior during the successive plays. The matching digit in the comparison number reflects the user's increased chance of winning. The actual outcome number displayed is still determined by a separate pseudo-random generator, but from a smaller subset of numbers. Therefore, claim 4 is not obvious over the combination of references applied by the Examiner.

With regard to claim 5, there is no teaching in any of the references of the probability of winning a game being different than the recited value that is based on the number of digits in the comparison number. Therefore, claim 5 is not obvious over the combination of references applied by the Examiner.

Claim 29 has been amended to recite that the game of chance comprises displaying a number selected by the user along with a number that represents the outcome for each play of the game. Claim 29 is allowable for the same reasons that claim 3 is allowable. Claim 30, which depends from claim 29, has been amended to recite that the user can increase the probability of

winning the product by participating in a survey. Claim 30 is allowable for the same reasons that claims 2 and 29 are allowable.

The Examiner rejected claims 6, 11, 16, 26 and 28 under 35 USC § 103(a) as being unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghourri, et al.* (U.S. 2002/0082978), and further in view of *Angles, et al.* (U.S. 5,933,811). This rejection is traversed.

Claim 11 recites that the user can increase his chance of winning on successive plays by performing a task for which a third party provides compensation. *Angles, et al.* teaches, at column 16, lines 38-45, that a consumer can be paid with digital cash for viewing an advertisement and can use the digital cash to purchase goods and services over the Internet. Providing digital cash to a consumer for viewing an advertisement is akin to receiving a coupon to use in purchasing a product. Modifying the teachings of *Walker, et al.* and *Ghourri, et al.* with the digital cash taught by *Angles, et al.* does not teach or suggest the inventive step of allowing a user to view an advertisement to increase his chance of winning a game. Therefore, claim 11 and claims 6, 16 and 28, which were rejected for the same reasons, are allowable over this combination of references.

Claim 26 has been amended to recite that the advertising sponsor provides funds to the game provider. Support for this amendment is found at page 14, lines 22-23 and page 15, lines 11-16. Claim 26 depends indirectly from claim 22 and is allowable over this combination of references for at least the same reasons that claim 22 is allowable.

The Examiner rejected claim 30 under 35 USC § 103(a) as being unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghourri, et al.* (U.S. 2002/0082978), and further in view of

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Angles, et al. (U.S. 5,933,811) and *Yoseloff* (U.S. 6,331,143). This rejection is traversed. Applicants incorporate by reference the remarks made above concerning the teachings of these references. Specifically, claim 30 is allowable for the same reasons that claims 1, 2, 11 and 29 are allowable.

In view of the above, it is submitted that the rejections of the Examiner have been properly addressed and that the pending claims are in condition for allowance. Such action at an early date is earnestly solicited. It is also requested that the Examiner contact Applicants' attorney at the telephone number listed below should this response not be deemed to place this application in condition for allowance.

Respectfully submitted,



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